

#5



**CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Mail Stop Petition, Commissioner for Patents  
P.O. Box 1450, Alexandria, VA 22313-1450  
on December 3, 2003.

(Attorney Signature)

Martin C. Fiesler, Reg. No. 25,656  
Signature Date: December 3, 2003

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

<b>In Re Application of:</b>	James J. Nicholas III	<b><u>PATENT APPLICATION</u></b>
<b>Application No.:</b>	10/029,887	<b>Group Art Unit:</b> 2154
<b>Confirmation No.:</b>	6031	<b>Examiner:</b> V. Vu
<b>Filing Date:</b>	December 20, 2001	
<b>Title:</b>	NON-INTRUSIVE INTERACTIVE NOTIFICATION SYSTEM AND METHOD	<b><u>Customer No. 23910</u></b>

**PETITION TO CORRECT PRIORITY CLAIM  
UNDER 37 C.F.R. 1.78(A)(3)**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicant hereby petitions to correct the priority claim of this application under 37 C.F.R. § 1.78(A)(3) pursuant to the provisions of MPEP § 201.11. Applicant also requests that the proposed amendment to the specification correcting the priority claim be entered.

12/08/2003 AHONDAF1 00000091 10029887

01 FC:1454

1330.00 OP

**FACTUAL BACKGROUND**

Applicant filed this application on December 20, 2001. The specification, as filed, provided a priority claim as follows:

This is a continuation-in-part of co-pending U.S. Patent Application Serial No. 09/632,474, filed on August 4, 2000, incorporated by reference herein, which itself claims priority to co-pending U.S. Patent Application Serial No. 09/314,128, filed on May 19, 1999, incorporated by reference herein. (A copy of the first page is attached as EXHIBIT A)

Attorney Docket No.: TNPR-01008US0  
mcf/tnpr/1008us0.Petition Priority Claim.doc

A declaration was also filed with the application that provided that the application claimed priority under 35 U.S.C. § 120 to both the 09/632,474 application and the 09/314,128 application. (Copy attached as **EXHIBIT B**) The declaration did not indicate the type of priority claimed for each application (e.g., continuation, continuation-in-part, etc.)

On February 8, 2002 Applicant's representative received a Filing Receipt issued by the Office that included a priority claim only to the immediately prior case 09/632,474. (Copy attached as **EXHIBIT C**) This application then published on May 16, 2002 as publication number US2002/0057285.

### **PETITION**

#### **A. PROPOSED AMENDMENT OF SPECIFICATION TO INCLUDE REFERENCE REQUIRED BY 35 U.S.C. § 120**

Applicant is filing a Preliminary Amendment herewith which includes the following amendment to the specification:

This application is a continuation-in-part of co-pending U.S. Patent Application Serial No. 09/632,474, filed on August 4, 2000, the specification of which is incorporated by reference herein, which itself claims priority to co-pending is a continuation-in-part of U.S. Patent Application Serial No. 09/314,128, filed on May 19, 1999, the specification of which is incorporated by reference herein.

#### **B. SURCHARGE REQUIRED BY 37 C.F.R. §1.17(t)**

Applicant submits a check in the amount of \$1,330 in payment of the surcharge required under 37 C.F.R. § 1.17(t).

#### **C. STATEMENT THAT DELAY IN FILING CLAIM WAS UNINTENTIONAL**

Applicant filed this application December 20, 2001. At the time the application was filed, Applicant and its representatives believed that the priority claim statement in the application (**EXHIBIT A**) and in the declaration (**EXHIBIT B**) was sufficient to effect a priority claim under 35 U.S.C. § 120.

It has come to the Applicant's attention that the priority claim to the original application, 09/314,128, was not effected.

Applicant hereby states that the delay between December 20, 2001, the filing date of this application, and today's date was unintentional.

### CONCLUSION

For the foregoing reasons, Applicant requests that this Petition be allowed and the priority claim for this application be amended to include a claim to 09/314,128 as provided for above. There is no prejudice to the public by allowing this Petition because the publication date of the application would not have changed had the priority been earlier corrected. Further, the public was on notice of the intended priority claim because it was set forth in the opening paragraph of the application as filed and published.

### FEES


The Commissioner is authorized to charge any underpayment or credit any overpayment to **Deposit Account No. 06-1325** for any matter in connection with this Petition, including any fee for extension of time, which may be required.

Respectfully submitted,

Dated:

Dec. 3, 2003

By:

  
Martin C. Fliesler  
Registration No. 25,656

**FLIESLER DUBB MEYER & LOVEJOY LLP**  
Four Embarcadero Center, Fourth Floor  
San Francisco CA 94111-4156

Telephone: 415.362.3800  
Facsimile: 415.362.2928

EXHIBIT A

## **NON-INTRUSIVE INTERACTIVE NOTIFICATION SYSTEM AND METHOD**

Inventor:

5

James J. Nicholas, III

This is a continuation-in-part of co-pending U.S. Patent Application Serial  
No. 09/632,474, filed on August 4, 2000, incorporated by reference herein, which  
itself claims priority to co-pending U.S. Patent Application Serial No. 09/314,128,  
10 filed on May 19, 1999, incorporated by reference herein.

### **BACKGROUND OF THE INVENTION**

#### **Field of the Invention**

[0001] This invention relates to an improved method for displaying  
15 messages on a display driven by an electronic device that has a graphical user  
interface, and more particularly to a method of displaying messages to which the  
user's attention will be drawn. The invention further relates to a centralized  
notification system and method that receives and manages notification alerts  
containing notification data from a variety of resources, and generates and  
20 distributes interactive notifications to a variety of recipients.

## EXHIBIT B

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application

Inventor: James J. Nicholas, III  
SC/Serial No.: Unknown  
Confirm. No.: Unknown  
Filed: Herewith  
Title: NON-INTRUSIVE INTERACTIVE NOTIFICATION  
SYSTEM AND METHOD

PATENT APPLICATION

Art Unit:  
Examiner:

Customer No. 23910

**DECLARATION FOR C-I-P PATENT APPLICATION**

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name;

I believe I am the original, first and sole inventor, of the subject matter which is claimed and for which a patent is sought on the invention of the **present application**:

Title of invention and of **present application**:

**NON-INTRUSIVE INTERACTIVE NOTIFICATION SYSTEM AND METHOD**

The specification of the **present application**:

✓ is filed herewith;

\_\_\_\_\_ was filed with the above-identified "Filed" date and "SC/Serial No."

\_\_\_\_\_ was amended on (or amended through) \_\_\_\_\_.

I have reviewed and understand the contents of the above-identified specification for the **present application**, including the claims, as amended by any amendment(s) referred to above.

I acknowledge the duty to disclose information which is material to the examination of the **present application** in accordance with Title 37, Code of Federal Regulations, §1.56.

This **present application** in part discloses and claims subject matter disclosed in, and I hereby claim the benefit under Title 35, United States Code §120 of any United States **prior application(s)** listed below:

(1) <u>09/314,128</u> (SC/Serial No.)	<u>May 19, 1999</u> (Filing Date)	<u>Pending</u> (Status-pending, patented, abandoned)
(2) <u>09/632,474</u> (SC/Serial No.)	<u>August 4, 2000</u> (Filing Date)	<u>Pending</u> (Status-pending, patented, abandoned)

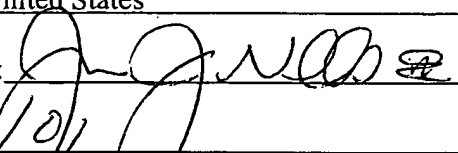
Insofar as the subject matter of each of the claims of the **present application** is not disclosed in the United States **prior application(s)** in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations §1.56 which occurred between the filing date(s) of the **prior application(s)** and the national or PCT international filing date of this **present application**.

(1) Full name of sole inventor: James J. Nicholas, III

(1) Residence: 63 Fairview Avenue, Atherton, California 94027

(1) Mailing Address: 63 Fairview Avenue, Atherton, California 94027

(1) Citizenship: United States

(1) Inventor's signature: 

(1) Date: 12/19/01

\*\*\*\*\*

Title 35, United States Code §120

**SECTION 120. BENEFIT OF EARLIER FILING DATE IN THE UNITED STATES**

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

Title 35, United States Code, §112 (first paragraph)

**SECTION 112. SPECIFICATION**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Title 37, Code of Federal Regulations, §1.56

**SECTION 1.56. DUTY TO DISCLOSE INFORMATION MATERIAL TO PATENTABILITY**

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§1.97(b)-(d) and 1.98.\* However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

- (1) prior art cited in search reports of a foreign patent office in a counterpart application, and
- (2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

- (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or
- (2) It refutes, or is inconsistent with, a position the applicant takes in:
  - (i) Opposing an argument of unpatentability relied on by the Office; or
  - (ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (1) Each inventor named in the application;
- (2) Each attorney or agent who prepares or prosecutes the application; and
- (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.

(d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.

\* §§1.97(b)-(d) and 1.98 relate to the timing and manner in which information is to be submitted to the Office.

## EXHIBIT C



## UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
www.uspto.gov

APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLAIMS	IND CLAIMS
10/029,887 ✓	12/20/2001 ✓	2176	742		21	52 ✓	5 ✓

CONFIRMATION NO. 6031 ✓

MARK E. MILLER  
FLIESLER DUBB MEYER & LOVEJOY LLP  
Fourth Floor  
Four Embarcadero Center  
San Francisco, CA 94111-4156

RECEIVED

FEB 08 2002

FLIESLER DUBB  
MEYER & LOVEJOY

## FILING RECEIPT



\*OC000000007412572\*

Date Mailed: 02/04/2002

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

## Applicant(s)

James J. Nicholas III, Atherton, CA; ✓

## Domestic Priority data as claimed by applicant

THIS APPLICATION IS A CIP OF 09/632,474 08/04/2000 ✓

## Foreign Applications

If Required, Foreign Filing License Granted 02/01/2002 ✓

Projected Publication Date: 05/16/2002 ✓

Non-Publication Request: No ✓

Early Publication Request: No ✓

\*\* SMALL ENTITY \*\* ✓

## Title

Non-intrusive interactive notification system and method ✓

## Preliminary Class

707

FLIESLER DUBB MEYER & LOVEJOY  
WBSP - 01008156  
Action #1?  
Date Due: February 20, 2003 ✓  
Critical Date: February 20, 2003  
Attorney Path: MEM/LLB  
Docketed By: max  
Verified By: SA

---

**LICENSE FOR FOREIGN FILING UNDER  
Title 35, United States Code, Section 184  
Title 37, Code of Federal Regulations, 5.11 & 5.15**

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).